

REMARKS

Favorable reconsideration of the subject application is respectfully requested in view of the following remarks. Claims 55-60, 69 and 70 are currently pending and under consideration.

Rejection Under 35 U.S.C. § 103(a)

Claims 56-60 and 69 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Rasmussen *et al.* More specifically, the Action asserts that Rasmussen *et al.* teaches an isolated polypeptide comprising a polypeptide sequence having 99.6% identity with SEQ ID NO:5 and that it would have been *prima facie* obvious to one of ordinary skill in the art to produce an isolated antibody to this polypeptide once it was isolated.

Applicants respectfully traverse this basis of rejection and submit that claims 56-60 and 69 are not obvious in light of Rasmussen *et al.*, since this reference fails to teach each element of the claimed invention. Applicants first note that the instant claims recite the feature that the claimed antibodies are specific for a caspase-14 polypeptide comprising SEQ ID NO:5 or a specifically identified fragment thereof. The polypeptide sequence described by Rasmussen *et al.* is not a caspase-14 polypeptide comprising SEQ ID NO:5, so any antibodies produced against the polypeptide of Rasmussen *et al.* would clearly not be specific for a caspase-14 polypeptide comprising SEQ ID NO:5. Accordingly, Applicants submit that Rasmussen *et al.* fails to render the claimed antibodies (and cells expressing these antibodies) obvious and respectfully request that this basis of rejection be withdrawn.

Furthermore, Applicants submit that even assuming *arguendo* that Rasmussen *et al.* taught each element of the claimed invention, Rasmussen *et al.* fails to render the claimed invention obvious, since the reference fails to provide the requisite teaching or suggestion of the desirability of the claimed invention. Applicants note that the mere fact that the teachings of the prior art *can* be combined or modified, or that a person having ordinary skill in the art is *capable* of combining or modifying the teachings of the prior art, does not make the resultant combination *prima facie* obvious, as the prior art must also suggest the desirability of the combination (*see, e.g., In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); *In re Fritch*, 23 USPQ2d

1780 (Fed. Cir. 1992)). Applicants note that Rasmusen *et al.* describes the sequencing of multiple proteins present in normal human keratinocytes, in an effort to integrate protein and DNA sequence information, identify protein sequence similarities, and prepare DNA probes to clone the genes corresponding to these proteins (page 960, lines 1-9). However, Rasmussen *et al.* fails to teach or suggest any advantage or desirability of producing antibodies specific for the identified polypeptides. While the Examiner asserts that the skilled artisan would have been motivated to produce antibodies to the antigen identified by Rasmussen *et al.* for the purpose of isolating and studying the expressed protein, Applicants disagree and submit that Rasmussen *et al.* fails to provide such motivation, since Rasmussen *et al.* provides no suggestion or motivation to further study the isolated polypeptide fragment with sequence similarity to SEQ ID NO:5. Rather, this polypeptide is just one of a great many polypeptide fragments microsequenced by Rasmussen *et al.* in an effort to establish a sequence database. In addition, Applicants submit that Rasmussen *et al.* fails to provide any teaching regarding the specifically recited functional fragments identified within the caspase-14 polypeptide of SEQ ID NO:5, *e.g.*, the large and small subunits and, thus, provides absolutely no motivation to produce antibodies specific for these fragments of caspase-14.

In light of the considerations addressed by the above remarks, Applicants submit that Rasmussen *et al.* clearly fails to provide the requisite teaching or motivation to produce the claimed antibodies and respectfully request that this basis of rejection be withdrawn.

Non-Statutory Double Patenting Rejection

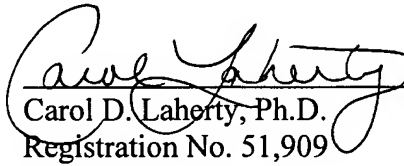
Claims 56-60, 69, and 70 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 61 and 64 of copending Application No. 09/989,903 ('903). Without acquiescence to this basis of rejection, Applicants submit herewith a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c), thereby obviating this basis of rejection. Applicants respectfully request that this basis of rejection be withdrawn.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Applicants respectfully submit that all of the claims in the application are allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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Enclosure:

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